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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/779,782

02/08/2001

Frank Venegas JR.

IDS-14502/14

6741

25006

7590

09/30/2009

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EXAMINER

CANFIELD, ROBERT

ART UNIT

PAPER NUMBER

3600

MAIL DATE

DELIVERY MODE

09/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/779,782	<b>Applicant(s)</b> VENEGAS, FRANK	
	<b>Examiner</b> ROBERT J. CANFIELD	<b>Art Unit</b> 3600	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-9, 11, 12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11, 12, and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/10/06 & 11/13/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/14/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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1. This Office action is in response to the Appeal Brief and after Final amendment filed 08/14/07. Claims 2-9, 11, 12 and 14-21 are pending. As noted in the Advisory Action mailed 08/21/09 the amendment after Final filed 08/14/07 has been entered. During an Appeals conference in response to the Appeal Brief it was determined that prosecution needed to be reopened once again as there is at least an outstanding 35 USC 112 first paragraph issue which has never been addressed by the previous or instant examiner. The finality of the previous Office action is withdrawn. The examiner apologizes for both the delay of the response and the piecemeal prosecution.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 2-9, 11, 12, and 14-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no written description of the cover being molded of a rigid or semi-rigid molded plastic. The language "rigid or semi-rigid" is not found in the original disclosure. The only description of the material begins at line 21 of page 5 and continues to line 8 of page 6 where the material has been defined as "a resilient, durable, and exposure resistant structural plastic that includes materials

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such as low-density polyethylenes and LEXAN brand polycarbonate". A plastic that is "rigid or semi-rigid" is considered to be of different scope than structural plastic and not fully supported by the original disclosure. There is no standard provided as to what is included or excluded by "rigid or semi-rigid". While structural plastic may be rigid or semi-rigid, all rigid or semi-rigid plastics are not necessarily structural plastics.

There is no written description that the panels of the cover are opaque. This limitation was added for the first time in the amendment filed 10/14/03 to overcome the 07/08/03 rejection under 35 USC 102(b) in view of U.S. Patent 3,874,103 to Muta. There is no mention in the originally filed disclosure that the panels are opaque. Page 6 lines 4-8, recites that "various coloring agents may be mixed into the material of which the cover 10 is formed to provide a durable color throughout, and a variety of material enhancing additives may be used, including, but not limited to, additives to resist ultraviolet deterioration, or glow-in-the-dark phosphorescent materials, for example." This language does not support the limitation of opaque as colored plastics including additives are not limited to opaque but could be translucent.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 2, 4, 8, 9, 11, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 3,307,282 to Caulkins.

Caulkins provides a plastic cover 22 comprised of spaced front and back semi-circular (figure 3), opaque (col. 2, line 41) panels 24 with an additional side panel placed there between (column 2, lines 18-20). Figure 2 shows the arc shape. The cover is intended to be placed over automotive tires, which are inherently at least 6 inches wide so the panels must be spaced 6 or more inches. Figure 2 shows a smooth transition at approximately 12 for the rounded edges of the tire. An advertising display of stenciled letters is shown in figures 1 and 3. The plastic material of Caulkins is considered to meet the limitation of a "semi-rigid" plastic as no standard has been provided in the instant application to determine the degree of rigidity of "semi-rigid".

Alternatively, it would have been obvious at the time of the invention to one having ordinary skill in the art that the plastic envelope of Caulkins could have been made from a rigid, a semi-rigid, or a structural plastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). One of ordinary skill in the art would have readily recognized that any of rigid, a semi-rigid, or a structural plastics work to meet the objects of Caulkins invention set forth at column 1, lines 35+. Each of rigid, a semi-rigid, or a structural plastics

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are: attractive in appearance, have good wear resisting qualities, would keep a tire clean and protected, are inexpensive, and may be simply slipped off. There would have been no unexpected or unpredictable results obtained from substituting known rigid, a semi-rigid, or a structural plastics for the plastic used in the envelope of Caulkins. One of ordinary skill in the art would have readily recognized that rigid or structural plastic would perform the objects of the invention just as readily as a film or flaccid plastics.

6. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 1,629,777 to Dahl.

Dahl provides a cover 12 comprised of spaced front and back panels (figure 3), each having a corresponding bottom edge. A semi-circular side panel spaces and connects the front and back panels in a smooth transition without sharp edges as shown at the top of figure 3. The side panel has an arc-shape when viewing from the front or back as seen in figures 1 or 2. A slot is open at the bottom for reception of a tire. The cover is capable of covering and corresponding to the outer diameter of a tubular metal guard rail. Dahl further provides fasteners 26/28 capable of securing the cover to the guard rail.

7. Claims 2-4, 8, 9, 11, 12, 14, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,629,777 to Dahl.

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Dahl provides a cover 12 comprised of spaced front and back panels (figure 3), each having a corresponding bottom edge. A semi-circular side panel spaces and connects the front and back panels in a smooth transition without sharp edges as shown at the top of figure 3. The side panel has an arc-shape when viewing from the front or back as seen in figures 1 or 2. A slot is open at the bottom for reception of a tire. The cover is capable of covering a tubular metal guard rail. Dahl further provides fasteners 26/28 capable of securing the cover to the guard rail.

Dahl is silent on the material of the cover and thus fails to provide that the cover is made from a rigid or semi-rigid molded plastic which is opaque.

Dahl further fails to specify that the front and back panels are spaced by six inches or more.

While Dahl is silent as to the material of his cover the cross sectional hatching is that of metal which is both rigid and opaque. Further suggestion that the material is rigid is provided by the use of the hardware 26/67 attached to the cover. It would have been obvious at the time of the invention to one having ordinary skill in the art that the cover of Dahl could have made from a rigid, a semi-rigid, or a structural plastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). One of ordinary skill in the art would have readily recognized that any of rigid, a semi-rigid, or a structural plastics work to

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meet the objects of the Dahl cover. Molded plastics would have been an obvious material choice for their inherent material properties such as ease in shaping, strength to weight and corrosion resistance. There would have been no unexpected or unpredictable results obtained from substituting known rigid, a semi-rigid, or a structural plastics for the material of the cover 12 of Dahl.

While Dahl is silent as to the spacing of the front and back panels it would have been an obvious matter of design choice to modify the structure of Dahl to have a spacing of six inches or more since such a modification would have involved a mere change in the size that would allow the cover to accommodate tires having a width of six or more inches. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). There would have been no unexpected or unpredictable results from spacing the front and back panels of Dahl six or more inches.

With respect to claims 2 and 4, the use of displays, advertisements, messages, decals, etc. on the outside of vehicle bodies is old and well known. It would have been obvious at the time of the invention to one having ordinary skill in the art that the cover of Dahl could have been provided with a display or stenciled message as a matter of design choice. There would have been no unexpected or unpredictable results achieved by providing a display or stenciled message on the cover of Dahl.



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8. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,629,777 to Dahl in view of U.S. Patent 3,307,282 to Caulkings .

Dahl provides each of the elements of the claims as noted above except the cover is provided with an advertising display and more particularly that the display is a message of stenciled letters.

Caulkings provides that at the time of the invention it was known that to provide advertising display in the form of stenciled letters on a tire cover. It would have been obvious at the time of the invention to one having ordinary skill in the art that a display or stenciled message could have been provided on the cover of Dahl particularly in light of the teachings of Caulkins. The use of displays, advertisements, messages, decals, etc. on the outside of vehicle bodies is old and well known. There would have been no unexpected or unpredictable results achieved by providing a display or stenciled message on the cover of Dahl.

9. Claims 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,629,777 to Dahl in view of U.S. Patent 1,960,668 to Fackiner .

Dahl provides each of the elements of the claims as noted above except the cover is provided with an advertising display and more particularly that the display is electrical circuit comprising lighting elements and stenciled letters.

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Fackiner provides that at the time of the invention it was known that to provide an advertising display with stenciled letters (figure 1) and lights 16. It would have been obvious at the time of the invention to one having ordinary skill in the art that the display of Fackiner could have been provided on the cover of Dahl particularly in light of the teachings of Fackiner. The use of displays, advertisements, messages, decals, etc. on the outside of vehicle bodies is old and well known. There would have been no unexpected or unpredictable results achieved by providing a display as taught by Fackiner with the cover of Dahl if one desired to provide a lighted message on the outside of the cover of Dahl.

10. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,629,777 to Dahl in view of U.S. Patent 5,852,890 to Pynenburg .

Dahl provides each of the elements of the claims as noted above except the cover is provided with an advertising display and more particularly that the display is one or more magnetically mounted objects disposed on a metallic surface.

Pynenburg provides that at the time of the invention advertising displays having one or more magnetically mounted objects 16-26 disposed on a metallic surface 44 were old and well known.

It would have been obvious at the time of the invention to one having ordinary skill in the art that a display of one or more magnetically mounted

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objects disposed on a metallic surface could have been provided on/with the cover of Dahl particularly in light of the teachings of Pynenburg. The use of displays, advertisements, messages, decals, etc. on the outside of vehicle bodies is old and well known. There would have been no unexpected or unpredictable results achieved by providing a display as taught by Pynenburg with the cover of Dahl if one desired to provide a readily changeable message on the outside of the cover of Dahl.

11. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 1,629,777 to Dahl in view of U.S. Patent 6,021,593 to Hite.

Dahl provides each of the elements of the claims as noted above except the cover is provided with an advertising display and more particularly that the display uses hook and loop materials.

Hite provides that at the time of the invention it was known to use hook and loop materials 22/24 in an advertising display.

It would have been obvious at the time of the invention to one having ordinary skill in the art that a display using hook and loop materials could have been provided on or with the cover of Dahl particularly in light of the teachings of Hite. The use of displays, advertisements, messages, decals, etc. on the outside of vehicle bodies is old and well known. There would have been no unexpected or unpredictable results achieved by providing a display as taught by Hite on or with the cover of Dahl if one

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desired to provide a readily changeable message on the outside of the cover of Dahl.

12. Applicant's arguments filed 08/14/07 have been fully considered but they are not persuasive.

Applicant argues that the language "rigid or semi-rigid" is supported by the original disclosure because the original specification discloses the use of "structural plastic" which any person skilled in the art would recognize as being "rigid or semi-rigid". This is not found persuasive because while structural plastics such as low density polyethylenes and LEXAN may be considered rigid or semi-rigid plastic, all rigid or semi-rigid plastics are not necessarily structural plastics. Thus the language of the claims is not fully supported by the original disclosure. Applicant very well could have used the language "structural plastic" in the claims, which has support in the original disclosure.

Applicant argues that the cover of Caulkins does not meet the limitation of "semi-rigid" as it is made from a plastic "film" which is draped or hung loosely. It remains the examiner's position that a plastic film meets the broadest reasonable interpretation of a "semi-rigid" plastic. Alternatively, a new grounds of rejection has been made stating it would have been obvious at the time of the invention to one having ordinary skill in the art that the plastic envelope of Caulkins could have been made from a rigid, a semi-rigid, or a structural plastic since it has been held to be within the general skill of a worker in the art to select a known

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material on the basis of its suitability for the intended use as a matter of obvious design choice.

The examiner notes the Appeal Brief filed 08/14/07 is defective for failing to fully comply with 37 CFR 41.37 (b) (v) as the summary of the claimed invention fails to map every element of the claims to the specification and use reference numerals to map the elements to the drawings. Any subsequently filed Appeal Brief must specifically point out where each element of the claim(s) may be found in the specification and use reference numerals to show where the claimed elements are shown in the drawings.

The examiner invites applicant's representative to contact him at the number provided below if it is deemed that prosecution could be advanced by having a telephonic interview.

13. The information disclosure statement (IDS) submitted on 06/14/07 has been considered by the examiner.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See cover *f* of USP 336,600 to Tennent.

USP 1,068,892 to Green teaches a rigid cover 4 having semi-circular panels spaced by a semi-circular panel having smooth transitions.

See cover 7 of USP 1,182,994 to Draver.

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USP 1,724,281 to Hathorn and 1,948,578 to Hasley teach that it was known at the time of the invention to use lighted stenciled lettering for advertising displays on vehicle tire covers.

USP 1,733,918 to Spotswood and 1,879,761 to Neiler et al teach that it was known at the time of the invention to use stenciled lettering for advertising displays on vehicle tire covers.

USP 1,794,498 to Ridgway teaches a cover 1 having the claimed shape, indicia of the front panel and formed from any suitable material.

See Cover 24 of USP 1,846,134 to McKormick et al.

See cover 10 of USP 2,942,226 to Low.

USP 3,112,966 to Reid teaches a hard plastic container formed of spaced panels 21 and 22, having a semi-circular upper portion and flat open bottom edge.

USP 3,336,382 to Genin teaches that using magnets and chalkboard surfaces was known for displays.

USP 4,273,429 to Florian teaches a formed plastic container 11 having a shape similar to what is disclosed and claimed.

USP 4,516,620 to Mulhern teaches it is known to provide a cover over a rail 13.

See element 12 of USP 4,715,646 to Goffi.

USP 4,771,862 to Garland teaches a cover 10 having spaced apart panels having a flat bottom edge and semi-circular upper portion which is made from a molded thermoplastic rubber.

See cover 1 formed from hard plastic of USP 4,778,179 to Balaz.

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USP 4,936,479 to Levy et al. teaches a formed plastic container 28 having a shape similar to what is disclosed and claimed.

See cover 10 of USP 5,228,608 to Stout.

USP 5,005,306 to Kinster teaches that at the time of the invention using lights, magnets and stenciling were all known for displays.

USP 5,809,606 to MacDonald teaches a cover formed of spaced semi-circular panels made of a light, easy to handle synthetic type material.

USP 6,159,577 to Pynenburg et al. and 3,826,026 to Bevan teach that using magnetic advertising displays was known at the time of the invention.

USP 7,299,578 to Molinaro shows an advertising cover 10 over a rail 15. It is noted that the reference does not qualify as prior art.

USP 7,506,465 to Hansen shows an advertising cover over a rail 24 in figure 7. It is noted that the reference does not qualify as prior art.

15. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the electrical/electronic circuit, one or more lighting elements, magnetically mounted objects disposed on a metallic surface, hook and look materials, and chalkboard surface all must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

16. Any inquiry concerning this communication should be directed to ROBERT J. CANFIELD at telephone number (571)272-6840.

Robert J Canfield  
SPE  
Art Unit 3635

/Robert J Canfield/

Supervisory Patent Examiner, Art Unit 3635